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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,987	12/28/2001	Glenn M. Baruck	214098	9148

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/22/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

v

Office Action Summary	Application No.	Applicant(s)
	10/033,987	BARUCK, GLENN M.
Examiner	Art Unit	
Ted Kavanaugh	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 August 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dancewear 1999 in view of US 5035069 (Minden).

Dancewear 1999 (see page 3 and/or 4) show a split sole ballet shoe (pointe shoe) substantially as claimed except for a rigid toe box (claims 1 and 31), the sole attached by adhesive (claim 6), a shank (claims 8-13), a midsole (claims 14-18), a sock liner (claim 29), a flat tip toe box (claim 23) and the materials as claimed. Minden teaches ballet shoe (e.g. pointe shoes) are typically formed with a rigid toe box made out of paper, glue, fabrics, cardboard, etc. (see col. 1, lines 14-28) and plastic (see col. 4, lines 11-13). It would have been obvious to provide the shoe of Dancewear 1999 with a rigid toe box to facilitate the wearer standing on their toes. Minden teach providing a ballet shoe (pointe shoe) with a shank, see col. 4, line 65 to col. 5, line 5. It would have been obvious to provide the ballet shoe as taught above with a shank to provide the necessary stiffness and increase comfort for the wearer. Regarding the size of the shank (i.e. full, three fourth and one-half), Minden teaches using these sizes at col. 4, line 65 to col. 5, line 5. In the specification applicant points out that multiple different size shanks can be used and therefore the size of the shank is merely

preferred. Accordingly, the claimed shank size (i.e. full, three-fourth and one-half) merely amounts to a matter of engineering design choice and thus does not serve to patentable distinguish the claimed invention over the prior art. This view is buttressed by applicant's disclosure, which does not reveal that the use of the specific size shank solves any particular problem and/or yields any unexpected results. Therefore, it would appear to be obvious to construct the shank of any desired length depending on the particular wearer.

Regarding the soles attached to the upper by adhesive, Dancewear 1999 shows the sole attached by sewing. It would have been obvious to attach the soles as taught above to the upper by adhesive inasmuch as substitute the one fastener for another is of no apparent patentable criticality and because a number of different fastening means appear suitable. The examiner takes official notice that it is old and conventional in the art to attach a sole to the upper by adhesive. Using adhesive would be a simpler means of attaching the components together.

Regarding the midsole, Minden teaches providing a midsole (shock absorbing layer 24, see col. 5, lines 25-52. It would have been obvious to provide the pointe shoe as taught above with a midsole, as taught by Minden, to provide additional shock absorption and reduce the noise of impact.

Regarding the different material being claimed (i.e. shank is redboard or leather; toe box is made out of paper and glue or paper, glue and fiber or plastic; the upper is made out of satin), it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the shank, toe box and upper out of these

materials as claimed, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 23, Minden teaches a flat tip toe box, see col. 4, lines 47-57. It would have been obvious to provide the pointe shoe as taught above with the toe box having a flat tip, as taught by Minden, to facilitate dance maneuvers.

Regarding the sock liner, the examiner takes official notice that sock liners are old and conventional in the art and are used to provide additional comfort to the wearer. Therefore, it would have been obvious to provide the pointe shoe as taught above with a sock liner to provide additional comfort.

Regarding claim 30 and 31, the pointe shoe as taught above follow the obvious method of assembly the shoe as claimed.

Response to Arguments

3. Applicant's arguments filed August 4, 2003 have been fully considered but they are not persuasive.

Applicant argues "there exist no motivation or suggestion to combine the split sole design known from ballet slippers with the traditional toe box pointe shoe." Applicant argues "Ballet slippers and pointe shoes are functionally different shoes for distinct styles of dance".

The examiner doesn't understand applicant arguments since the footwear of Minden and Dancewear 1999 appear to be very similar. Regarding claims 1 and 31, Dancewear 1999 teaches a split sole ballet shoe substantially as claimed except for a

rigid toe box. However, the reference (Dancewear 1999) teaches it is for Ballet and Pointe. Pages 3 and 4 appear to shoe "pointe shoes" with the split sole as claimed. It would appear the ballet shoes of Dancewear 1999 on pages 3 and 4 appear to shoe a rigid toe box but since it was not clear that is why Minden reference was applied since Minden clearly taught a ballet shoe (e.g. pointe shoe) with a rigid toe box. Regarding a pointe shoe having a rigid toe box, see page 6, second paragraph of applicant's remarks, which provide further support that pointe shoes have a rigid toe box. As far as motivation to combine, assuming the ballet shoes on either pages 3 or 4 of Dancewear 1999 don't teach a rigid toe box, it would be obvious to add a rigid toe box, as taught by Minden, to facilitate the wearer standing on their toes. As applicant points out pointe shoes "enhance the appearance of being suspended in air".

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

5. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (FORMAL FAXES ONLY). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov .

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
August 20, 2003